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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/842,027

04/26/2001

Per Willars

2380-232

6903

7590

09/21/2005

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EXAMINER

PIZARRO, RICARDO M

ART UNIT

PAPER NUMBER

2662

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/842,027	Applicant(s) WILLARS ET AL.	
	Examiner Ricardo Pizarro	Art Unit 2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/26/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-68 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,9,14,15,24,26,32,37 and 38 is/are rejected.
- 7) ☒ Claim(s) 2,6-8,10-13,16-23, 25,27-31,33-36,39-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-5 , 9, 24, 26, 32, and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent No. 6,801,542(Subbiah).

Regarding claims 1 and 24 , Subbiah disclose a Method and apparatus for providing an interworking unit between ATM and IP networks, having an application layer (i.e.inherent since is needed for exchange of messages, col 6 lines 18-22) and a transport 2 layer (AAL2, 450 in Fig. 4), the system comprising: a first node which utilizes a first transport technology (First ATM node 420 in Fig. 4) a second node which utilizes a second transport technology (Second IP node 430 in Fig. 4) wherein the first transport technology (ATM technology) and the second transport technology (IP technology) are interworked for facilitating establishment of a transport bearer between the first node (Node 420 in Fig. 4) and the second node (node 430 in Fig.4) without interworking with application control signaling in the application layer

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(Interworking takes place via Interworking gateway 410 in Fig. 4 without application signaling, col 5 lines 30-38) .

Regarding claims 3 and 26, further comprising a transport layer interworking gateway connected between the first and the second node (Gateway 410 is connected between the first and second node)

Regarding claim 4, wherein the interworking gateway receives an establish request message by the first transport technology and converts an address of the second node borne by the establish request message to an address usable by the second transport technology to send a signaling message to the second node (Gateway unit 500 is responsible for converting AAL2 signaling messages 530 to H.323 or SIP signaling messages 532 to be sent to the second node, col 6 lines 18-22)

Regarding claim 5, wherein the first technology is ATM and the second technology is IP (col 4 lines 31-32)

Regarding claim 9 and 32, wherein the first node uses an address of the second node to determine an address for the interworking gateway, and wherein the first node sends a bearer signaling message to the interworking gateway.(AAL2 signaling message 530 sent from the ATM node to the Gateway, col 5 line 46).

Regarding claims 15 and 38, where an interworking function interworks the first technology and the second technology at a node distinct from the first node and the second node. (IWF at the Interworking Gateway 410 , different node from the first and second)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent No. 6,801,542(Subbiah).

Subbiah does not disclose , where an interworking function interworks the first technology and the second technology at one of the first node and the second node , as in claim 14 and 37.

However it would have been obvious to one of ordinary skill in the art as a matter of design choice, to modify the Subbiah reference by changing the location of the IWF function to either node in the system or even locate the IWF function within one of the nodes since applicant has not disclosed that the location of the IWF function would affect the performance of the system and it appears that the IWF function would perform equally well in either location.

The motivation to do so is to obtain a system where maintenance is simplified and space is saved.

Allowable Subject Matter

5. Claims 47-68 are allowed.

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Claims 2,5-8 10-13, 16-23, 25, 27-31, 33-36, 39-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

Examiner's statement of reasons for Allowance

6. The following is an examiner's statement of reasons for allowance:

For claims 47 and 56, no prior art of record was found for a telecommunications system having an application layer being the radio access network layer and a transport layer, wherein a first node attempts to establish a transport bearer between the first node and a second node using application level signaling, but when unsuccessful invokes an interworking function in the transport layer for establishing the transport bearer

For claims 65 and 67, no prior art of record was found for a telecommunication system having a first node, a second node connected to the IP, wherein the second node obtains address parameters of a transport layer interworking gateway for inclusion in application layer signaling to the first node in order to enable the first node to use the transport layer interworking gateway for purposes of establishing a transport bearer between the first and second node.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US patent No. 6,621,793 discloses an Application influenced Policy.
- US patent No. 6,879, 566 discloses Connection establishment in a wireless network.
- US patent No. 6,490,284 discloses the use of CIC in conjunction with AAAL type 2 signaling protocol.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300

(for formal communications intended for entry, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to 220 South 20th Street, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Va 22202 (Customer Window).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Ricardo Pizarro** whose telephone number is (571) 272-3077. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. .

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Hassan Kizou** can be reached on (571) 272-3088

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 14, 2005
Ricardo Pizarro



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600